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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,041	12/06/2001	Kevin P. Baker	GNE.2830PIC8	8875

7590 02/27/2004

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EXAMINER

KAPUST, RACHEL B

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,041

Applicant(s)

BAKER ET AL.

Examiner

Rachel B. Kapust

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

According to the priority statement of September 9, 2002, the claimed subject matter defined in the instant application is supported by parent application serial nos. 09/946374, PCT/US00/04342, PCT/US99/28313, 09/403297, PCT/US99/20111, and 60/099596. Based on the information given by applicant and an inspection of the patent applications, the examiner has concluded that the subject matter defined in this application is supported by the disclosure in application serial no. PCT/US00/04342, filed February 18, 2000 but is not supported by any of the earlier applications because no utility for the polypeptide, PRO 1244, to which the claimed antibody binds, is disclosed in the earlier applications. The results of the endothelial cell proliferation assay and mouse kidney mesangial cell proliferation assay are first reported in PCT/US00/04342. Accordingly, the subject matter defined in claims 28-47 has an effective filing date of February 18, 2000.

Should the Applicant disagree with the examiner's factual determination above, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to February 18, 2000 that specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession of and fully enabled prior to February 18, 2000.

Specification

The use of the trademarks LIFESEQ™ (p. 409), SUPERFECT™ (p. 480), FUGENE™ (p. 480), SEPHAROSE™ (p. 483), LYMPHOLYTE MTM (p. 486), FLIPR™ (p. 488), and TAQMAN™ (p. 490) have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28, 31, and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 28, 31, and 33 are drawn to antibodies that bind to a polypeptide comprising SEQ ID NO: 130, all of which are products of nature. Thus, they are not articles of “manufacture”. These rejections may be obviated by amending the claims to read “an isolated antibody” or “a purified antibody” so long as there is support for the amendment in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 is drawn to an antibody that specifically binds to a polypeptide comprising SEQ ID NO: 130 (PRO1244). The term “specifically binds” is a relative term which renders the claims indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one skilled in the art would not be reasonably apprised of the scope of the invention. It is unclear what amount of binding would be considered to be “specific”. One skilled in the art would not know what the metes and bounds of specific binding are.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0096951 (Jacobs *et al.*). These claims encompass antibodies that bind to a polypeptide comprising SEQ ID NO: 130. Jacobs *et al.* teach SEQ ID NO: 4 which is 100% identical to SEQ ID NO: 130 (see attached alignment). Jacobs *et al.* further teach monoclonal antibodies, humanized antibodies, labeled antibodies, and fragments of antibodies (paragraphs 3442 and 3443). Thus, claims 28-31 and 33 are anticipated by Jacobs *et al.*

Claims 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,525,174 (Young *et al.*). The claims are as stated above. Young *et al.* teach SEQ ID NO: 1189, which is 99.4% identical to SEQ ID NO: 130 over residues 29-187 of SEQ ID NO: 130. Young *et al.* further teach monoclonal antibodies, antibody fragments, labeled antibodies, and humanized antibodies (Example 10). The antibodies as taught by Young *et al.* would bind to the polypeptide comprising SEQ ID NO: 130.

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Conclusion

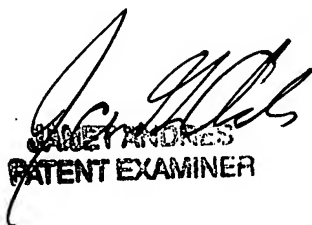
NO CLAIMS ARE ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel B. Kapust whose telephone number is (571) 272-0886. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RBK
2/17/04


RACHEL B. KAPUST
PATENT EXAMINER